

REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed March 9, 2007. Through this response, claims 105, 122, and 125 have been amended, and claims 106, 112, 123, and 124 have been canceled without prejudice, waiver, or disclaimer. Reconsideration and allowance of the application and pending claims 105, 108-111, 113-115, 122, and 125-139 are respectfully requested.

I. Claim Rejections - 35 U.S.C. § 103(a)

A. Rejection of Claims 105-106, 108-115, and 122-139

Claims 105-106, 108-115, and 122-139 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Ellis, et al.* ("Ellis," U.S. Pat. No. 6,898,762 B2) in view of *LaRocca, et al.* ("LaRocca," U.S. Pat. No. 6,314,572 B1) and *Mathai, et al.* ("Mathai," U.S. Patent No. 6,847,969 B1). Applicants have amended claims 105, 122, and 125, and have canceled claims 106, 112, 123, and 124 thereby rendering the rejection of these claims moot. Applicants respectfully submit that the claims 105, 108-111, 113-115, 122, and 125-139 are allowable over the art of record.

B. Discussion of the Rejection

The U.S. Patent and Trademark Office ("USPTO") has the burden under section 103 to establish a *prima facie* case of obviousness according to the factual inquiries expressed in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). The four factual inquiries, also expressed in MPEP 2100-116, are as follows:

- (A) Determining the scope and contents of the prior art;
- (B) Ascertaining the differences between the prior art and the claims in issue;
- (C) Resolving the level of ordinary skill in the pertinent art; and

(D) Evaluating evidence of secondary considerations.

Applicants respectfully submit that a *prima facie* case of obviousness is not established using the art of record.

Independent Claim 105

Claim 105 recites (emphasis added):

105. A method implemented by a television set-top terminal (STT) configured to provide television programs and a viewer's preference for advertisement categories, the method comprising:

outputting to a television by the STT a graphical user interface (GUI) that comprises a menu having a plurality of viewer selectable advertisement categories, said plurality of viewer selectable advertisement categories including a first advertisement category and a second advertisement category that is different from the first advertisement category;

receiving by the STT a first viewer input corresponding to the first advertisement category and a second viewer input corresponding to the second advertisement category;

responsive to receiving the first and second viewer inputs, storing the first and second advertisement categories in the memory of the STT configured to store the viewer's preference for advertisement categories;

receiving a first advertisement and a second advertisement by the STT from a remote server after the STT receives the first and second viewer inputs;

***storing the first and second advertisements in the STT;
receiving at a future time, a television program by a tuner in the STT;***

outputting the television program to the television by the STT; and
outputting the stored first and second advertisements to the television by the STT during an interruption in the presentation of the television program being output by the STT.

Applicants respectfully submit that the rejection of claim 105 has been rendered moot.

Additionally, Applicants respectfully submit that *Ellis* in view of *LaRocca* and *Mathai* fails to disclose, teach, or suggest at least the above emphasized claim features. Thus, for at least this reason, Applicants respectfully request the rejection of claim 105 be withdrawn.

Because independent claim 105 is allowable over *Ellis* in view of *LaRocca* and *Mathai*, dependent claims 108 - 111 and 113 - 115 are allowable as a matter of law for at

least the reason that the dependent claims 108 - 111 and 113 - 115 contain all elements of their respective base claim. See, e.g., *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

Independent Claim 122

Claim 122 recites (emphasis added):

122. A television set-top terminal (STT) system, comprising:

STT logic configured to output to a television a graphical user interface (GUI) that comprises a menu having a plurality of selectable advertisement categories, receive a plurality of viewer inputs respectively corresponding to selections made from the menu having the plurality of selectable advertisement categories, responsive to receiving the plurality of viewer inputs, store in a memory of the STT the viewer-selected advertisement categories, after receiving the plurality of viewer inputs, receive advertisement data components corresponding exclusively to respective advertisements corresponding to the viewer selected advertisement categories, ***store the advertisement data components in the memory of the STT, and output the respective advertisements to the television during intermittent future interruptions of the presentation of television programs not yet received at the STT output to the television at a future time.***

Applicants respectfully submit that the rejection of claim 122 has been rendered moot.

Additionally, Applicants respectfully submit that *Ellis* in view of *LaRocca* and *Mathai* fails to disclose, teach, or suggest at least the above emphasized claim features. Thus, for at least this reason, Applicants respectfully request that the rejection of claim 122 be withdrawn.

Because independent claim 122 is allowable over *Ellis* in view of *LaRocca* and *Mathai*, dependent claims 125 - 127 are allowable as a matter of law.

Independent Claim 128

Claim 128 recites (emphasis added):

128. (Previously Presented) A method implemented by a television set-top terminal (STT), comprising:

outputting to a television by the STT a graphical user interface (GUI) that comprises a menu having a plurality of viewer-selectable advertisement categories;

receiving by the STT a plurality of viewer inputs respectively corresponding to viewer-selected advertisement categories from the plurality of selectable advertisement categories, wherein the viewer inputs are provided by a viewer of the television; and

responsive to receiving the plurality of viewer inputs, outputting to the television by the STT a plurality of commercials respectively corresponding to at least one of the viewer-selected advertisement categories.

Applicants respectfully submit that *Ellis* in view of *LaRocca* and *Mathai* fails to disclose, teach, or suggest at least the above emphasized claim features. For example, Applicants have reviewed the cited references in full and have failed to find any teaching of the claimed feature of “responsive to receiving the plurality of viewer inputs, outputting to the television by the STT ***a plurality of commercials*** respectively corresponding to at least one of the viewer-selected advertisement categories.” Thus, for at least this reason, Applicants respectfully request that the rejection of claim 128 be withdrawn.

Because independent claim 128 is allowable over *Ellis* in view of *LaRocca* and *Mathai*, dependent claims 129 - 139 are allowable as a matter of law.

II. Canceled Claims

As identified above, claims 106, 112, 123, and 124 have been canceled from the application through this Response without prejudice, waiver, or disclaimer. Applicants reserve the right to present these canceled claims, or variants thereof, in continuing applications to be filed subsequently.

CONCLUSION

Applicants respectfully submit that the pending claims are in condition for allowance. Favorable reconsideration and allowance of the present Application and all pending claims are hereby courteously requested. Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and official notice, and similarly interpreted statements, should not be considered well known since the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,

/dr/

David Rodack
Registration No. 47,034

**THOMAS, KAYDEN,
HORSTEMEYER & RISLEY, L.L.P.**
Suite 1750
100 Galleria Parkway N.W.
Atlanta, Georgia 30339
(770) 933-9500